

IV. Claims 23-40, Drawn To A Method of Cosmetic And Surgical Treatment Using Hydrogel, Classified in Class 128, Subclass 898.

In addition, it was asserted that the claims are directed to patentably distinct species of the claimed invention, i.e., the method of treatment including cosmetic; mammoplastic reconstruction; penile enlargement; body contouring; and treatment for oesophagitis. Office Action, page 3, last paragraph. It was required that Applicant elect a single disclosed species for prosecution on the merits to which the claims will be restricted if no generic claim is held allowable. Applicant was also required to list all claims readable on the species elected in accordance with the requirement. Office Action, page 4.

II. ELECTION WITH TRAVERSE

Applicant elects, with traverse, for further prosecution the claims of Group I. With respect to the issue of election of species, Applicant respectfully points out that the election of species is directed to claims in Group IV and therefore is moot with respect to the prosecution of the claims of Group I. In the event the restriction requirement is withdrawn (as it should be for all the reasons detailed herein), Applicant elects, with traverse, the species of the method of treatment including cosmetic. In such an event, the following claims will read on the elected species: claims 1-29 and 38. If the restriction requirement is not withdrawn and the Patent Office is of the opinion that the election of species requirement applies to Group I, claims 1-12 read on the elected species.

In the Office Action it was stated that the inventions identified in the above-identified purported separate groups were distinct from each other for several reasons.

First, it was asserted that inventions of Groups I and II were related as mutually exclusive species in an intermediate-final product relationship. It was stated that distinctness was proven for claims in this relationship if the intermediate product was useful to make other than the final product, and the species were patentably distinct. The MPEP §806.04(b), 3rd paragraph and MPEP §806.04(h) were relied upon for that assertion. According to the text of the Office Action, in the instant case, the intermediate product was deemed to be useful as moisturizers and the inventions were patentably distinct since there was nothing in the record to show them to be obvious variants. Further, it was stated that, should the Applicant traverse on the ground that the species were not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this was the case. Office Action, page 2. It was indicated that in either case if the Examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under U.S.C. § 103(a) of the other invention. *Id.*

Second, it was asserted that Groups II and III were related as process of making and product made and that they can be shown to be distinct if either or both of the following can be shown:

1. the process as claimed can be used to make other and materially different process of using that product; or
2. the product as claimed can be made by another and materially different process.

The MPEP, § 806.05(f) was relied upon for that assertion. It was said that in this instant case the hydrogel may be made from rooster's combs. Office Action, page 3.

Third, it was asserted that Groups II and IV were related as product and process of use and that they can be shown to be distinct if either or both of the following can be shown:

1. the process for using the product as claimed can be practiced with another materially different product; or
2. the product as claimed can be used in a materially different process of using that product.

The MPEP, § 806.05(h) was relied upon for that assertion. It was said that in the instant case the method can be performed using hydrogel from rooster's combs and does not require the specifics of the product of Group II. *Id.*

Finally, it was asserted that these inventions were distinct for the reasons given above and had acquired a separate status in the art because of their recognized divergent classification, and restriction for examination purposes as indicated was proper. *Id.*

Applicant respectfully traverses the restriction requirement. The Examiner has stated that Groups I and II are related as mutually exclusive species in an intermediate-final product relationship. Here, Group I is drawn to the hydrogel wherein the hydrogel comprises less than 3.5% by weight polyacrylamide and Group II is drawn to a hydrogel comprising less than 3.5 % polyacrylamide used as an endoprosthesis. As stated in the Office Action, distinctness is proven for claims if the hydrogel is useful for making other products than the endoprosthesis. Given the hydrogel is novel in itself, the Applicant respectfully submits that there is no evidence that the hydrogel having less than 3.5% polyacrylamide is useful as a moisturizer. In the absence of such evidence, the

Applicant respectfully requests that Groups I and II are directed to similar inventions and traverses the division of the Group I from Group II.

Further, Group III is drawn to a process of making a hydrogel so as to give less than 3.5% by weight polyacrylamide, based on the total weight of the polyacrylamide. Claim 1 relates to the hydrogel comprising less than 3.5% polyacrylamide. According to the Office Action, the two groups (II and III) would be patentably distinct if (1) the process as claimed can be used to make another and materially different product or (2) if the product as claimed can be made from another materially different process. The product claims of Group II are similar to the product of the process claims of Group III. Thus, the claims of Group II should be examined together with those of Group III.

In addition, it was stated that inventions of Groups II and IV are related as product and process of use. According to the Office Action, the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially distinct product, or (2) the product as claimed can be used in a materially different process of using that product. Applicant submits that the product claims of Group II are directed to a similar subject matter as the product of the process claims of group IV.

In view of the above remarks, it is respectfully requested that the restriction requirement and the election of species requirement be withdrawn and that at least claims in Groups I, II and III be pooled and examined on the merits in the application at this stage. In the event that the requirements are made final, and in order to comply with 37 CFR § 1.143, Applicant reaffirms the election of claims 1-12 (Group I), holding

the remaining claims (Groups II, III and IV) in abeyance under the provisions of 37 CFR § 1.142(b) until final disposition of the elected claims.

III. REQUEST FOR ALLOWANCE

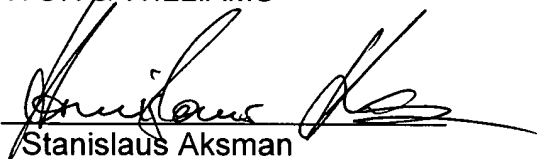
All claims are in condition for allowance, an indication of which is solicited. In the event any outstanding issues remain, Applicant would appreciate the courtesy of a telephone call to the undersigned counsel to resolve such issues in an expeditious and effective manner.

In the event that any additional fees are necessary, the Commissioner is hereby authorized to charge our Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

Dated: May 19, 2003

By: 
Stanislaus Aksman
Registration No. 28,562

1900 K Street, NW, Suite 1200
Washington, DC 20006
(202) 955-1926—Telephone
(202) 778-2201—Facsimile